

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

190252-1720

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Signature _____

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Application Number

09/750,138

Filed

December 29, 2000

First Named Inventor

Malik

Art Unit

2143

Examiner

Neurauter, George C.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 58,169☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

/BAB/

Signature

Benjamin A. Balser

Typed or printed name

(770) 933-9500

Telephone number

June 25, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Malik

Serial No.: 09/750,138

Filed: December 29, 2000

Confirmation No.: 6782

Group Art Unit: 2143

Examiner: Neurauter, George C.

Docket No.: 190252-1720

For: Method and Apparatus for Managing and Compacting Electronic Mail Messages

REMARKS IN SUPPORT OF
PRE-APPEAL BRIEF CONFERENCE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants submit the following remarks in support of a Request for a Pre-Appeal Brief Conference.

REMARKS

Applicant submits that the following clear legal deficiency exists in the rejection. Namely, the previous Office Action equates "determining whether a message has been previously compressed" with the basic operation of compressing a message, which are two functions that are known to be technically very different from each other. The Advisory Action seems to allege that determining whether a message has been previously compressed is inherent in the basic operation of compressing a message. Even if the cited reference, *Shaffer*, discloses compressing a message, as pointed out on page 2 of the Advisory Action mailed May 3, 2007, *Shaffer* fails to disclose "determining whether a message has been previously compressed," nor is the determination inherent in compressing a message. Therefore, the reference does not disclose the cited element, and the rejections should be withdrawn.

I. Status

Claims 1-3, 6-8, 15, and 21-45 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by *Shaffer, et al.* (U.S. Patent No. 6,842,768). These rejections are respectfully traversed.

II. Rejections of Independent Claims 1, 21, and 35 Under 35 U.S.C. §102(e)

Independent claims 1, 21, and 35 are rejected under 35 U.S.C. 102(e) as allegedly being anticipated by *Shaffer, et al.* (U.S. Patent No. 6,842,768).

Independent claim 1 recites:

1. A method for automatically managing an electronic mail server application on a host computer, comprising:
checking an electronic mail message against a predetermined criteria;

determining whether the message has been previously compressed;
compacting a non-attachment portion of the electronic mail message if the
predetermined criteria is satisfied and if the message has not been
previously compressed; and
storing the compacted electronic mail message.
(Emphasis added).

Applicant respectfully submits that claim 1 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. § 102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue. See, e.g., *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1 is allowable for at least the reason that *Shaffer* does not disclose, teach, or suggest at least **determining whether the message has been previously compressed**. Even if, assuming for the sake of argument, *Shaffer* discloses the compression of a file, *Shaffer* fails to disclose determining whether the file was previously compressed. The Final Office Action asserts that “a file may have an infinite number of varying degrees of compression.” See *Office Action*, pg. 3. Applicant respectfully submits that there may be many ways to determine whether a file has been previously compressed, including determining if the file is a “zipped file” as disclosed on page 11 of the Specification. Additionally, a particular file may be compressed many times, using different compression methods. In claim 1, a determination is made regarding whether the file has been previously compressed. This may be performed using various methods, but no particular method is claimed. If the file has not been previously compressed, the file is compacted. However, *Shaffer* clearly fails to disclose any method whatsoever of determining if the

file has been previously compressed, regardless of any method used to compress the file. A message size, by itself, without knowledge of a previous message size, does not indicate whether a file has been compressed.

The Advisory Action appears to allege that determining if a file has been previously compressed is inherent in compressing a file. "Anticipation by inherency requires that 1) the missing descriptive matter be 'necessarily present' in the prior art reference ..." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). A file could certainly be compressed without determining whether it has been previously compressed; so, the determining is not necessarily present. Therefore, determining if a file has been previously compressed is not inherent to the disclosure of *Shaffer*.

Applicant respectfully submits that *Shaffer* does not anticipate independent claim 1, and the rejection should be withdrawn for at least that reason. Independent claims 21 and 35 include similar recitations as independent claim 1 and are also allowable over *Shaffer* for at least the reasons given above.

For at least the reason that the independent claims are allowable over the cited references of record, the dependent claims are allowable as a matter of law for at least the reason that the dependent claims contain all the features of the independent claims. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002); *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since the dependent claims are patentable over *Shaffer*, the rejection to the dependent claims should be withdrawn and the claims allowed.

CONCLUSION

For at least the reasons set forth above, favorable reconsideration and allowance, or the re-opening of prosecution on the merits of the present application and all pending claims are hereby courteously requested.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**

/BAB/

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